

Serial No. 10/056,258
December 22, 2003
Reply to the Office Action dated September 26, 2003
Page 5 of 8

REMARKS/ARGUMENTS

Claims 2-12 are pending in this application. By this Amendment, Applicants AMEND claims 2 and 8-12.

Applicants greatly appreciate the Examiner's indication that claims 3-7 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims.

The Examiner objected to claims 8-12 for allegedly containing minor informalities. Applicants have amended claims 8-12 to correct the minor informalities noted by the Examiner. Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to claims 8-12.

Claim 2 was rejected under 35 U.S.C. § 102(b) as being anticipated by Forterre et al. (US Patent No. 5,495,210). Applicants respectfully traverse the rejection of claim 2.

Claim 2 has been amended to recite:

"A method of manufacturing a nonreciprocal circuit device comprising a **metal case covering central conductors, a ferrite core arranged near the central conductors, and a permanent magnet for applying a static magnetic field to the ferrite core**, the method comprising the steps of:

marking information onto the metal case by irradiating the metal case with a laser beam; and

heating the nonreciprocal circuit device after the information has been marked onto the metal case." (emphasis added)

Applicants' claim 2 recites the features of "a metal case covering central conductors, a ferrite core arranged near the central conductors, and a permanent magnet for applying a static magnetic field to the ferrite core" and "marking information onto the metal case by irradiating the metal case with a laser beam." With the improved features of claim 2, Applicants have been able to provide a method of manufacturing a nonreciprocal circuit device in which marking is performed thereon without reducing the

Serial No. 10/056,258
December 22, 2003
Reply to the Office Action dated September 26, 2003
Page 6 of 8

amount of product information (see, for example, the first full paragraph on page 5 of the originally filed Specification).

First, the Examiner has alleged, in the second paragraph on page 3 of the outstanding Office Action, that the preamble of claim 2 should not be given patentable weight because the features recited therein are intended use features. However, the Examiner is reminded that "if the claim preamble, when read in the context of the entire claim, recites limitations of the claims, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claims." See Pitney Bowes, Inc. v. Hewlett-Packard Co., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). In addition, the Examiner is reminded that any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) and MPEP § 2111.02.

Applicants respectfully submit that the feature of "a metal case covering central conductors, a ferrite core arranged near the central conductors, and a permanent magnet for applying a static magnetic field to the ferrite core" clearly recites limitations of the claim when read in the context of the entire claims and further recites structural features. Thus, Applicants respectfully submit that the Examiner has erred by not giving the preamble patentable weight.

Second, the Examiner has alleged, in the first paragraph on page 3 of the outstanding Office Action, that metallic layer 4 of Forterre et al. teaches the metal case recited in Applicants' claim 2. However, Forterre et al. clearly teaches in Figs. 2 and 3 that the metallic layer 4 does not cover the permanent magnet 7. Thus, Forterre et al. clearly fails to teach or suggest "a metal case **covering** central conductors, a ferrite core arranged near the central conductors, and a permanent magnet for applying a static magnetic field to the ferrite core" (emphasis added) as recited in Applicants' claim 2.

Third, the Examiner has alleged, in the first paragraph on page 3 of the

Serial No. 10/056,258
December 22, 2003
Reply to the Office Action dated September 26, 2003
Page 7 of 8

outstanding Office Action, that holes 24 of Forterre et al. teach the feature of "marking information onto the metal case by irradiating the metal case with a laser beam" as recited in Applicants' claim 2. Merriam-Webster's Online Dictionary defines the term "information" as "communication or reception of knowledge or intelligence." The Examiner has completely failed to explain how the holes 24 of Forterre et al. could be considered to communicate or receive knowledge, especially in view of the fact that the holes are covered by casing 8. Thus, Forterre et al. fails to teach or suggest the feature of "marking information onto the metal case by irradiating the metal case with a laser beam" as recited in Applicants' claim 2.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. § 102(b) as being anticipated by Forterre et al.

Accordingly, Applicants respectfully submit that none of the prior art of record, applied alone or in combination, teaches or suggests the unique combination and arrangement of elements recited in claim 2 of the present application. Claims 3-12 depend upon claim 2 and are therefore allowable for at least the reasons that claim 2 is allowable.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

Serial No. 10/056,258
December 22, 2003
Reply to the Office Action dated September 26, 2003
Page 8 of 8

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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